



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
ON APPEAL FROM THE EXAMINER TO THE BOARD  
OF PATENT APPEALS AND INTERFERENCES**

In re Application of: SOLOMON, et al.  
Serial No.: 09/470,580  
Filing Date: December 22, 1999  
Group Art Unit: 3622  
Examiner: James W. Myhre  
Title: REBATE PROCESSING SYSTEM AND METHOD  
OFFERING SELECTABLE DISBURSEMENT OPTIONS

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Date of Deposit: March 21, 2005

**Reply Brief**

Appellants have appealed to this Board from the decision of the Examiner, contained in a Final Office Action mailed July 12, 2004 (the "Final Office Action"), finally rejecting Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38. Appellants mailed a Notice of Appeal on October 12, 2004. The Examiner responded in an Examiner's Answer mailed January 21, 2005 (the "Examiner's Answer"). Appellants respectfully submit this Reply Brief.

In the Examiner's Answer, the Examiner continues to rely on *Small*, *Walker*, and *Finsterwald* and reiterates many of his earlier arguments with little variation – despite Appellants having demonstrated major flaws in these arguments in the Appeal Brief. The

Examiner's Answer attempts to address Appellants' analysis. However, in attempting to rebut this analysis, the Examiner's Answer simply highlights again the deficiencies of the references. In the interest of brevity, this Reply Brief will address only selected points without providing a detailed reiteration of the analysis in the Appeal Brief.

**A. The New Double Patenting Rejection**

In the Examiner's Answer, the Examiner withdraws the rejection under 37 C.F.R. § 1.78(b) and instead imposes a double patenting rejection under the judicially created doctrine of obviousness-type double patenting. To the extent the Board permits the Examiner to now present this rejection, Appellants will respond as appropriate. Specifically, Appellants will file a terminal disclaimer if appropriate and necessary.

**B. Appellants have demonstrated that the Claims are patentable over *Small, Walker, and Finsterwald*, whether the references are taken alone or in combination and that the proposed combination is improper.**

In the Appeal Brief, Appellants demonstrated that that the proposed *Small-Walker-Finsterwald* combination fails to support the rejection of Appellants' claims for at least two reasons. First, the proposed combination fails to teach or suggest all elements of the claims. Second, the combination of *Small, Walker, and Finsterwald* is improper.

**1. *Small, Walker, and Finsterwald* fail to teach or suggest all aspects of the claims.**

Appellants pointed out two aspects of the claims conspicuously absent from the teachings of *Small, Walker, and Finsterwald*: (a) the aspects related to retrieving status information for a rebate request from a remote rebate processing center using a rebate transaction identifier; and (b) the claimed disbursement options having differing cash values.

**(a) Status information for a rebate request.**

Appellants demonstrated in the Appeal Brief that that the proposed *Small-Walker-Finsterwald* combination fails to teach or suggest the claimed aspects related to retrieving status information for a rebate request from a remote rebate processing center using a rebate transaction identifier. For teaching of the rebate request status aspects of the claims, the Final Office Action relied on *Walker* and *Finsterwald*. Appellants demonstrated in the Appeal Brief how *Walker's* discussion of a certificate database that tracks whether or not an issued

certificate has been redeemed fails to teach or suggest the rebate request status aspects of Appellants' claims. Appellants further demonstrated in the Appeal Brief how *Finsterwald's* discussion of a reward point account also fails to teach or suggest these same aspects.

In response to Appellants' arguments demonstrating the deficiencies of *Walker* and *Finsterwald*, the Examiner briefly notes the disclosures of *Walker* and *Finsterwald* and then delves into the Examiner's personal beliefs regarding unrelated technologies for which the Examiner presents no evidence. *See* Examiner's Answer, at pp. 11-12. These statements simply repeat or recast the Examiner's earlier assertions made in the Final Office Action and previously objected to by Appellants. Appellants have requested multiple times that, to the extent that the Examiner maintains any assertions based on "Official Notice," "well known prior art," "common knowledge," or other information within the Examiner's personal knowledge, the Examiner must cite a reference in support of that position or provide an affidavit in accordance with 37 C.F.R. § 1.104(d)(2) and M.P.E.P. § 2144.03. *See* Response After Final, at p. 13; Appeal Brief, at p. 16. However, to date the Examiner has not cited any reference or provided any affidavit. The Board should decline to accept the Examiner's attempt to reject the claims based on the Examiner's subjective beliefs that are in no way supported by the evidence of record.

**(b) Rebate information including at least two disbursement options.**

Appellants further demonstrated in the Appeal Brief that that the proposed *Small-Walker-Finsterwald* combination fails to teach or suggest the claimed aspects related to offering disbursement options with different cash values to the recipient. For teaching of these aspects, the Examiner's Answer points to the rebate form of *Small*, which allows a customer to request whether a rebate should be paid by check or to a credit card account. However, the claimed aspects relate to two or more disbursement options having different cash values to a recipient. A choice between receiving payment by check or by credit fails to teach or suggest disbursement options having *different cash values to a recipient*.

**2. The proposed *Small-Walker-Finsterwald* combination is improper.**

In the Appeal Brief, Appellants pointed out the Examiner's failure to cite any evidence teaching, suggesting, or motivating a combination of the cited references. In response, the Examiner's Answer relies on a fundamental mischaracterization of *Small* to

provide potential needs and advantages to support the combination. Specifically, the Examiner characterizes *Small* as teaching a system for processing rebate requests, stating:

The Examiner notes that processing a “redemption voucher” (Walker) or processing a “rebate request” (Small) are equivalents in the art. In either case, the processing center receives the request from the customer, verifies the authenticity and completeness of the request, and redeems the voucher or rebate. Thus, Small and Walker both pertain to processing requests from customers.

Examiner’s Answer, at pp. 13-14. However, as discussed in the Appeal Brief, *Small* does not address processing of rebate requests. Rather, *Small* discloses a bingo game capable of bringing rebate offers to a customer’s attention. In conjunction with this, *Small* discloses a rebate form. *Small* does not, however, address how the form would be processed or any other aspects of processing of a rebate request.

The mischaracterization of *Small* underpins the Examiner’s arguments in favor of the combination. For example, the Examiner’s Answer points to *Small*’s “need to keep the customer informed” during processing of a rebate request. *See Id.* at p. 14. Since *Small* does not teach processing of rebate requests, this “need” is simply a statement of the Examiner’s belief not based on evidence of record and not applicable to *Small*. In short, the bingo game of *Small* is not properly combinable with the processing system of *Walker* or the point reward system of *Finsterwald*, and the Examiner has failed to provide any evidence sufficient to support such a combination.

**Conclusion**

Appellants have demonstrated that the present invention, as claimed, is patentable over the prior art cited by the Examiner. Therefore, Appellants respectfully request the Board to reverse the final rejections and instruct the Examiner to issue a Notice of Allowance with respect to all pending claims.

Although Appellants believe no fees are due, the Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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